Remarks

The Office Action mailed November 16, 2006 and made final, and the Advisory Action dated March 5, 2007 have been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Applicants submit that none of the cited references describe or teach the "no-underwriting eligibility criteria" recited in the present claims. As discussed below in detail, the Office Action acknowledges at page 5 that Chapman does not describe, among other things, "the claimed no-underwriting eligibility criteria". Rather, the Office Action apparently relies on National Underwriter and Kern for supposedly teaching the claimed "no-underwriting eligibility criteria". Specifically, the Office Action asserts at page 6 that National Underwriter describes "a new policy that allows automatic renewal, without new underwriting at the end of the policy" and at page 22 that Kern describes "an automated system and method of compiling rates to be charged for standard worker's compensation policy…using the classification worksheet enters classification code, number of employees and the payroll".

However, National Underwriter describes a 10-year term life insurance plan that includes a new policy that allows for automatic renewal without new underwriting at the end of each 10-year insurance period. National Underwriter does not describe a no-underwriting eligibility criteria. Rather, National Underwriter merely describes a life insurance policy that automatically renews without applying any type of no-underwriting criteria. Moreover, since National Underwriter relates to life insurance, National Underwriter does not describe, suggest or even mention an insurance work classification of a subscriber or a number of employees of a subscriber.

Moreover, Kern describes a system that uses information relating to an employer (e.g., Glen Retirement Center) such as job classification, number of full-time employees, number of part-time employees, payroll, and insurance rate for the job classification *in order to calculate a premium for providing worker's compensation insurance to the employer*. (Emphasis added.) Kern does not describe a no-underwriting eligibility criteria. In fact, Kern describes a process that includes performing an underwriting process in order to gather information relating to an

insured. Kern then uses the gathered information such as job classification and number of full-time employees in order to calculate a premium for providing worker's compensation insurance to the employer. Kern does not describe, suggest or even mention using a no-underwriting eligibility criteria for determining each insurance policy eligible for a renewal evaluation without requiring external underwriting and risk assessment processes, wherein the no-underwriting eligibility criteria includes whether a change has occurred in an insurance work classification assigned to a subscriber and whether a change has occurred in a number of employees of the subscriber.

Accordingly, Applicants respectfully submit that neither National Underwriter nor Kern, or any of the other cited references, alone or in combination, describe or suggest the no-underwriting eligibility criteria as claimed herein. Applicants therefore submit that this application is allowable.

Applicants and the undersigned also wish to express their appreciation to the Examiner for the courtesies he extended during a telephone interview that occurred on January 16, 2007. During the interview, the Final Office Action dated November 16, 2006 was discussed. In addition, the undersigned discussed the differences between the present invention and Kern, U.S. 6,604,080. Specifically, the undersigned submitted that Kern does not describe, suggest, or even mention using a pre-determined criteria for determining whether an insurance policy is eligible for a renewal evaluation without requiring external underwriting and risk assessment processes wherein the no-underwriting eligibility criteria includes an insurance work classification or a number of employees.

Although no agreement was reached with respect to the patentability of the claims in the present case, the Examiner indicated that he would fully consider Applicants' arguments. The undersigned respectfully submitted that a Notice of Allowance should be issued in this case. The undersigned and the Examiner agreed that if a Notice of Allowance is not issued in this matter, the Examiner will contact the undersigned before issuing any Office Action to discuss the issues further. The foregoing Amendment has been made in consequence of the Examiner Interview.

Applicants respectfully submit that none of Chapman, National Underwriter, Business Wire or Kern, considered alone or in combination, describe or suggest the claimed invention. As discussed below, at least one of the differences between the cited references and the present invention is that none of Chapman, National Underwriter, Business Wire or Kern, considered alone or in combination, describe or suggest a method for evaluating insurance policy data corresponding to a proposed renewal policy for binding an associated insurance carrier and renewing the policy under the authority of a field agent geographically remote from the carrier, the method includes providing pre-determined criteria for determining each insurance policy eligible for a renewal evaluation without requiring external underwriting and risk assessment processes, wherein the no-underwriting eligibility criteria is pre-determined by the insurance carrier and *the no-underwriting eligibility criteria includes whether a change has occurred in an insurance work classification assigned to a subscriber of the corresponding insurance policy being evaluated for renewal without external underwriting and risk assessment processes, and whether a change has occurred in a number of employees of the subscriber.* (Emphasis added.)

More specifically, none of Chapman, National Underwriter, Business Wire or Kern, considered alone or in combination, describe or suggest a pre-determined criteria for determining each insurance policy eligible for a renewal evaluation without requiring external underwriting and risk assessment processes, wherein *the no-underwriting eligibility criteria includes whether a change has occurred in an insurance work classification assigned to a subscriber of the corresponding insurance policy being evaluated for renewal without external underwriting and risk assessment processes, and whether a change has occurred in a number of employees of the subscriber.* (Emphasis added.)

The Office Action acknowledges that Chapman, National Underwriter and Business Wire fail to teach "the claimed eligibility criteria include an insurance work classification assigned to a subscriber and a number of employees of the subscriber." However, the Office Action asserts that Kern teaches "an automated system and method of compiling rates to be charged for standard worker's compensation policy including the Glen Retirement Center using the classification worksheet enters classification code, number of employees and the payroll (see column 29, lines 38-43)."

As explained below, the system described in Kern does not describe or teach a pre-determined criteria for determining each insurance policy eligible for a renewal evaluation without requiring external underwriting and risk assessment processes wherein the no-underwriting eligibility criteria includes an insurance work classification or a number of employees. Rather, Kern describes a system that uses information relating to an employer (e.g., Glen Retirement Center) such as job classification, number of full-time employees, number of part-time employees, payroll, and insurance rate for the job classification in order to calculate a premium for providing worker's compensation insurance to the employer. Kern describes that the information used relating to the employer is gathered on a Worksheet as part of the underwriting process of the employer. In other words, Kern describes a system that merely uses information relating to a company for calculating an insurance premium after the company has undergone an underwriting process. Accordingly, Kern does not describe, suggest or even mention *using a pre-determined criteria for determining whether an insurance policy is eligible for a renewal evaluation without requiring external underwriting and risk assessment processes* wherein the no-underwriting eligibility criteria includes an insurance work classification or a number of employees.

Applicants respectfully submit that merely describing a system, as shown in Kern, that uses information relating to a company such as a job classification and number of employees to calculate an insurance premium does not describe or teach a pre-determined criteria for determining whether an insurance policy is eligible for a renewal evaluation *without requiring external underwriting and risk assessment processes* wherein the no-underwriting eligibility criteria includes an insurance work classification or a number of employees. In fact, Applicants submit that Kern teaches away from the present invention because Kern teaches calculating a premium *after conducting an underwriting process on a company* that includes gathering information relating to the company to respond to a plurality of questions on a worksheet. Accordingly, Applicants submit that Kern does not describe or suggest the present invention.

Claims 1-32 are pending in this application. Claims 1-32 stand rejected.

The rejection of Claims 1, 2, 4-11, 13-16 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Chapman et al. (U.S. Patent No. 6,526,386) ("Chapman") and National

Underwriter, *10-Year Term Allows Automatic Renewal Without Underwriting*, Vol. 97, Issue 16, April 1993 ("National Underwriter") in view of Business Wire, *ClientSoft Introduces eXoro, A Complete e-Service Solution for the Insurance Industry*, June 4, 1999 ("Business Wire") is respectfully traversed.

Applicants respectfully submit that none of Chapman, National Underwriter, or Business Wire, considered alone or in combination, describe or suggest the claimed invention. As discussed below, at least one of the differences between the cited references and the present invention is that none of Chapman, National Underwriter, or Business Wire, considered alone or in combination, describe or suggest a method for evaluating insurance policy data corresponding to a proposed renewal policy for binding an associated insurance carrier and renewing the policy under the authority of a field agent geographically remote from the carrier, the method including providing pre-determined criteria for *determining each insurance policy eligible for a renewal evaluation without requiring external underwriting and risk assessment processes*, wherein the *no-underwriting eligibility criteria includes whether a change has occurred in an insurance work classification assigned to a subscriber of the corresponding insurance policy being evaluated for renewal without external underwriting and risk assessment processes, and whether a change has occurred in a number of employees of the subscriber*. (Emphasis added.)

More specifically, none of Chapman, National Underwriter, or Business Wire, considered alone or in combination, describe or suggest a *no-underwriting eligibility criteria that includes whether a change has occurred in an insurance work classification assigned to a subscriber of the corresponding insurance policy being evaluated for renewal without external underwriting and risk assessment processes, and whether a change has occurred in a number of employees of the subscriber*. (Emphasis added.)

In fact, the Office Action acknowledges at page 22 that "Chapman, National Underwriter, and Business Wire fail to teach the claimed eligibility criteria [that] include an insurance work classification assigned to a subscriber and a number of employees of the subscriber." Accordingly, for at least this reason, Applicants respectfully submit that the present claims are patentable over Chapman and National Underwriter in view of Business Wire.

Chapman describes a system and method of generating automobile insurance certificates from a remote computer terminal connected by a computer network to a central computer. The method includes automatically flagging at least one expiring policy stored on the central computer, notifying a local user of at least one expiring policy from a list of the expiring policies, and electronically ordering and printing the insurance certificates at the remote computer.

National Underwriter is an article describing a 10-year term life insurance plan being marketed by Central Reserve Life of Strongsville, Ohio. The plan includes a new policy that allows for automatic renewal without new underwriting at the end of each 10-year insurance period.

Business Wire is an article describing a new Internet-based system for the Insurance Industry referred to as eXoro. The eXoro system is offered by ClientSoft. eXoro is described as an Internet-based, end-to-end system enabling insurance agents to rate, obtain quotes, apply for, underwrite, bind and issue insurance policies from any location in real time. According to the article, eXoro is expected to increase insurance industry revenues while reducing underwriting costs for property, automobile, homeowner, commercial and casualty insurance policies.

Claim 1 recites a method for evaluating insurance policy data corresponding to a proposed renewal policy for binding an associated insurance carrier and renewing the policy under the authority of a field agent geographically remote from the carrier, the insurance carrier has a local computer that includes an eligibility generator, the field agent has a remote computer that includes a data display in communication with the local computer, the method includes "storing in a database policy data relating to a plurality of insurance policies issued by the insurance carrier, the database in communication with the local computer…providing pre-determined criteria for determining each insurance policy eligible for a renewal evaluation without requiring external underwriting and risk assessment processes, the no-underwriting eligibility criteria is pre-determined by the insurance carrier, the no-underwriting eligibility criteria including whether a change has occurred in an insurance work classification assigned to a subscriber of the corresponding insurance policy being evaluated for renewal without external underwriting and risk assessment processes, and whether a change has occurred in a number of

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employees of the subscriber…identifying at least one insurance policy as being eligible for a renewal evaluation by applying the no-underwriting eligibility criteria to the policy data stored in the database for each insurance policy, the criteria applied to the policy data stored in the database using the eligibility generator…displaying at the field agent computer a Web page, the Web page including policy data corresponding to the at least one identified renewal policy…updating at the field agent computer the policy data corresponding to the at least one renewal policy by inputting data corresponding to attributes of a subscriber on Web pages displayed on the field agent computer…transmitting the updated policy data from the field agent computer to the associated insurance carrier…processing at the local computer the updated policy data for the at least one identified renewal policy to determine whether the identified renewal policy is eligible for renewal without requiring external underwriting and risk assessment processes…receiving at the field agent computer a proposed renewal policy based on the updated policy data including a premium amount for the subscriber if the at least one identified renewal policy is eligible for renewal…receiving at the field agent computer a bind Web page indicating that the proposed renewal policy for the subscriber is in condition such that the associated insurance carrier can be bound to the terms and conditions of the proposed renewal policy…and binding by the field agent the associated insurance carrier to the terms and conditions of the proposed renewal policy by prompting the field agent to enter a bind indication on the bind Web page and transmitting the bind Web page from the field agent computer to the carrier, the binding by the field agent legally binds the associated insurance carrier to the terms and conditions of the proposed renewal policy."

None of Chapman, National Underwriter or Business Wire, considered alone or in combination, describe or suggest a method as recited in Claim 1.

Specifically, none of Chapman, National Underwriter or Business Wire, considered alone or in combination, describe or suggest a method for evaluating insurance policy data corresponding to a proposed renewal policy for binding an associated insurance carrier and renewing the policy under the authority of a field agent geographically remote from the carrier, the method including providing pre-determined criteria for *determining each insurance policy eligible for a renewal evaluation without requiring external underwriting and risk assessment*

processes, wherein the *no-underwriting eligibility criteria includes <u>whether a change has</u>* <u>*occurred in an insurance work classification assigned to a subscriber of the corresponding*</u> <u>*insurance policy being evaluated for renewal without external underwriting and risk assessment*</u> <u>*processes, and whether a change has occurred in a number of employees of the subscriber*</u>. (Emphasis added.)

More specifically, none of Chapman, National Underwriter, or Business Wire, considered alone or in combination, describe or suggest a *no-underwriting eligibility criteria that includes* <u>*whether a change has occurred in an insurance work classification assigned to a subscriber of*</u> <u>*the corresponding insurance policy being evaluated for renewal without external underwriting*</u> <u>*and risk assessment processes, and whether a change has occurred in a number of employees of*</u> <u>*the subscriber*</u>. (Emphasis added.)

In fact, the Office Action acknowledges at page 22 that "Chapman, National Underwriter, and Business Wire fail to teach the claimed eligibility criteria [that] include an insurance work classification assigned to a subscriber and a number of employees of the subscriber." Accordingly, for at least this reason, Applicants respectfully submit that the present claims are patentable over Chapman and National Underwriter in view of Business Wire.

In addition, as set forth in the prior response to Office Action mailed December 28, 2005, Applicants respectfully submit that none of Chapman, National Underwriter or Business Wire, considered alone or in combination, describe or suggest other elements recited in Claim 1. The response filed by Applicants on December 28, 2005 is incorporated herein by reference.

For at least the reasons set forth above, Claim 1 is submitted to be patentable over Chapman and National Underwriter in view of Business Wire.

Claim 2 depends from independent Claim 1. When the recitations of Claim 2 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claim 2 likewise is patentable over Chapman and National Underwriter in view of Business Wire.

Claims 4-9 depend from independent Claim 3. The Office Action acknowledges at page 22 that "Chapman, National Underwriter, and Business Wire fail to teach the claimed eligibility criteria [that] include an insurance work classification assigned to a subscriber and a number of employees of the subscriber", which is recited in independent Claim 3. Because no combination of Chapman, National Underwriter and Business Wire describes or suggests the recitations of independent Claim 3, than no combination of Chapman, National Underwriter and Business Wire can describe the recitations of Claims 4-9 which depend from independent Claim 3.

Claim 10 recites a method for renewing a policy via Internet connections between a central data memory and a remote data memory, a policy issuer is associated with a central computer having an eligibility generator, the method includes "storing in the central data memory policy data relating to a plurality of policies issued by the policy issuer, the central data memory in communication with the central computer…providing pre-determined criteria for determining each policy eligible for a renewal evaluation without requiring external underwriting and risk assessment processes, the no-underwriting eligibility criteria is pre-determined by the policy issuer, the no-underwriting eligibility criteria including whether a change has occurred in an insurance work classification assigned to a subscriber of the corresponding policy being evaluated for renewal without external underwriting and risk assessment processes, and whether a change has occurred in a number of employees of the subscriber…identifying one or more policies as being eligible for a renewal evaluation by applying the no-underwriting eligibility criteria to the policy data stored in the database for each policy, the criteria applied to the policy data stored in the central data memory using the eligibility generator…generating in the remote data memory a first Web page including data identifying the one or more eligible policies for the renewal evaluation, the central data memory associated with the issuer of one or more eligible renewal policies, the remote data memory associated with a field agent located in a geographically remote location from the policy issuer…selecting by the field agent a policy from the identified one or more eligible policies…generating in the central data memory a request for policy data relating to the selected policy…generating in the central data memory and transmitting over a network one or more second Web pages arranged to include the requested renewal policy data along with a provision for inputting update data…receiving, displaying, updating in the remote memory, and transmitting from the remote memory, the one or more

second Web pages wherein said receiving, displaying, updating and transmitting is accomplished by the field agent...processing at the central computer the renewal policy data for the selected policy to determine whether the selected policy is eligible for renewal without requiring external underwriting and risk assessment processes...receiving and displaying in the remote memory a proposed renewal policy if determined that the selected policy is eligible for renewal...and binding the policy issuer to the proposed renewal policy associated with the renewal policy data, wherein said binding is accomplished by a decision process undertaken independently by the field agent without including external underwriting and risk assessment processes, and by transmitting to the central data memory from the remote data memory a third Web page including a binding indication data."

None of Chapman, National Underwriter, or Business Wire, considered alone or in combination, describe or suggest a method as recited in Claim 10. Claim 10, as herein amended, recites a method for renewing a policy that includes steps essentially similar to those recited in Claim 1. Thus, it is submitted that Claim 10 is patentable over Chapman and National Underwriter in view of Business Wire for the reasons that correspond to those given with respect to Claim 1.

For at least the reasons set forth above, Claim 10 is submitted to be patentable over Chapman and National Underwriter in view of Business Wire.

Claims 11 and 13-14 depend from independent Claim 10 which is submitted to be in condition for allowance. When the recitations of Claims 11 and 13-14 are considered in combination with the recitations of Claim 10, Applicants submit that dependent Claims 11 and 13-14 are also patentable over Chapman and National Underwriter in view of Business Wire.

Claim 15 recites a policy renewal system for renewing a policy under the authority of a field agent for binding an issuer of the policy after the policy has been identified as eligible for a renewal evaluation, the policy issuer having an eligibility renewal policy generator for generating policy data for at least one policy eligible for the renewal evaluation, the system includes "network...a database for storing policy data relating to a plurality of policies issued by the policy issuer...pre-determined criteria for determining each policy eligible for a renewal

evaluation without requiring external underwriting and risk assessment processes, the no-underwriting eligibility criteria is pre-determined by the policy issuer, the no-underwriting eligibility criteria including whether a change has occurred in an insurance work classification assigned to a subscriber of the corresponding policy being evaluated for renewal without external underwriting and risk assessment processes, and whether a change has occurred in a number of employees of the subscriber…a remote data display associated with a field agent and configured for displaying said policy data in a form readable by the field agent, the field agent located in a geographically remote location from the policy issuer…and the eligibility generator, the database and said remote data display connected to said network, the eligibility generator configured to identify at least one policy as being eligible for the renewal evaluation by applying the no-underwriting eligibility criteria to the policy data stored in the database for each policy, said remote data display configured to…receive over the network policy data relating to the at least one identified renewal policy…display said policy data relating to the at least one identified renewal policy…prompt the field agent to update the displayed policy data…transmit the updated policy data to the eligibility generator for processing…receive from the policy issuer a proposed renewal policy including the updated policy data if the eligibility generator determines that the at least one identified renewal policy is eligible for renewal…and enable the field agent to legally bind the policy issuer to a renewal of said proposed renewal policy associated with said updated policy data, the binding accomplished independently by the field agent without underwriting analysis or risk analysis by the policy issuer."

None of Chapman, National Underwriter, or Business Wire, considered alone or in combination, describe or suggest a method as recited in Claim 15. Claim 15, as herein amended, recites a policy renewal system that includes, among other things, a pre-determined criteria for determining each policy eligible for a renewal evaluation without requiring external underwriting and risk assessment processes, and an eligibility generator configured to perform steps essentially similar to those recited in Claim 1. Thus, it is submitted that Claim 15 is patentable over Chapman and National Underwriter in view of Business Wire for the reasons that correspond to those given with respect to Claim 1.

For at least the reasons set forth above, Claim 15 is submitted to be patentable over Chapman and National Underwriter in view of Business Wire.

Claim 16 depends from independent Claim 15 which is submitted to be in condition for allowance. When the recitations of Claim 16 are considered in combination with the recitations of Claim 15, Applicants submit that dependent Claim 16 is also patentable over Chapman and National Underwriter in view of Business Wire.

Claim 23 recites a system for renewing an insurance policy after the policy has been identified as eligible for a renewal evaluation, the system includes "pre-determined criteria for determining each policy eligible for a renewal evaluation without requiring external underwriting and risk assessment processes, the no-underwriting eligibility criteria is pre-determined by an insurance carrier, the no-underwriting eligibility criteria including whether a change has occurred in an insurance work classification assigned to a subscriber of the corresponding policy being evaluated for renewal without external underwriting and risk assessment processes, and whether a change has occurred in a number of employees of the subscriber…at least one computer configured as a server, said server comprising an eligibility generator coupled to a database of policy data for a plurality of insurance policies issued by the insurance carrier, said server associate with the insurance carrier, said eligibility generator configured to identify at least one insurance policy as being eligible for the renewal evaluation by applying the no-underwriting eligibility criteria to the policy data stored in the database for each insurance policy…and at least one remote computer including a user interface connected to said server through a network, said remote computer associated with a field agent located in a geographically remote location from the insurance carrier, said remote computer configured to…receive policy data from said server for an insurance policy identified as being eligible for the renewal evaluation wherein the policy data includes information relating to a subscriber of said policy…display said policy data on said user interface…prompt the field agent by displaying predetermined questions on said user interface to update the policy data…receive from the field agent updated policy data including updated subscriber information…display the updated policy data on the user interface such that the field agent can evaluate the updated policy data…transmit the updated policy data to said server to determine whether the identified insurance policy is eligible for renewal…receive from

said server a proposed renewal policy including a premium amount for the subscriber if said server determines that the identified insurance policy is eligible for renewal…and enable the field agent to legally bind the insurance carrier to the proposed renewal policy associated with the evaluated policy data, wherein the binding is accomplished by a decision process undertaken independently by the field agent without underwriting analysis and risk analysis by the insurance carrier."

None of Chapman, National Underwriter, or Business Wire, considered alone or in combination, describe or suggest a method as recited in Claim 23. Claim 23, as herein amended, recites a system for renewing an insurance policy that includes, among other things, a pre-determined criteria for determining each policy eligible for a renewal evaluation without requiring external underwriting and risk assessment processes, and at least one server configured to perform steps essentially similar to those recited in Claim 1. Thus, it is submitted that Claim 23 is patentable over Chapman and National Underwriter in view of Business Wire for the reasons that correspond to those given with respect to Claim 1.

For at least the reasons set forth above, Claim 23 is submitted to be patentable over Chapman and National Underwriter in view of Business Wire.

For at least the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 1, 2, 4-11, 13-16 and 23 be withdrawn.

The rejection of Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Chapman and National Underwriter in view of Business Wire and further in view of the Official Notice ("Official Notice") is respectfully traversed.

Chapman, National Underwriter, and Business Wire are all described above. The Official Notice taken by the Examiner is that "time restraints such as a five-minute limit being placed on any Internet transaction before a user is logged off and must logon back on to complete the transactions is old and well known in the computer industry."

Claim 12 depends from independent Claim 10. Claim 10 is recited hereinabove.

As discussed above, none of Chapman, National Underwriter or Business Wire, alone or in combination, describe or suggest a method as recited in Claim 10. Specifically, none of Chapman, National Underwriter or Business Wire, considered alone or in combination, describe or suggest a method for renewing a policy that includes providing pre-determined criteria for determining each policy eligible for a renewal evaluation without requiring external underwriting and risk assessment processes, wherein *the no-underwriting eligibility criteria includes __whether a change has occurred in an insurance work classification assigned to a subscriber of the corresponding policy being evaluated for renewal without external underwriting and risk assessment processes, and whether a change has occurred in a number of employees of the subscriber__*. (Emphasis added.)

The Official Notice does not make up for the deficiencies of Chapman, National Underwriter and Business Wire. Accordingly, for at least the reasons set forth above, Applicants respectfully submit that Claim 10 is patentable over Chapman and National Underwriter in view of Business Wire and further in view of the Official Notice.

When the recitations of Claim 12 are considered in combination with the recitations of Claim 10, Applicants submit that dependent Claim 12 likewise is patentable over Chapman and National Underwriters in view of Business Wire and further in view of the Official Notice.

The rejection of Claims 3, 17-22 and 24-32 under 35 U.S.C. § 103(a) as being unpatentable over Chapman and National Underwriter and Business Wire and further in view of Kern (U.S. Patent No. 6,604,080) is respectfully traversed.

Chapman, National Underwriter and Business Wire are all described above. Kern describes an automated system and method of computing rates to be charged for a new insurance product that provides coverage equivalent to that provided by a standard workers' compensation policy. The new insurance product having at least two separate, coordinated policies. The new product involves using one policy to insure the workers' compensation obligation (Part A of a standard workers' compensation policy), and a second policy to insure against the employers liability exposure (Part B of a standard workers' compensation policy). The system determines one set of rates for insuring employees in pre-determined employment classifications for the

workers' compensation policy and another set of rates for insuring the employees in other pre-determined employment classifications for the employers liability coverage.

Claim 3 recites a method for renewing an insurance policy under the authority of a field agent for binding an insurance carrier, the insurance carrier having a local computer including an eligibility generator, the field agent located in a geographically remote location from the insurance carrier, the field agent having a remote computer including a data display, the method including "storing in a database policy data relating to a plurality of insurance policies issued by the insurance carrier, the database in communication with the local computer…providing pre-determined criteria for determining each insurance policy eligible for a renewal evaluation without requiring external underwriting and risk assessment processes, the no-underwriting eligibility criteria is pre-determined by the insurance carrier, the no-underwriting eligibility criteria including whether a change has occurred in an insurance work classification assigned to a subscriber of the corresponding insurance policy being evaluated for renewal without external underwriting and risk assessment processes, and whether a change has occurred in a number of employees of the subscriber…identifying at least one insurance policy as being eligible for a renewal evaluation by applying the no-underwriting eligibility criteria to the policy data stored in the database for each insurance policy, the criteria applied to the policy data stored in the database using the eligibility generator…receiving at the field agent computer policy data reflecting an insurance policy identified as being eligible for a renewal evaluation…providing the field agent with predetermined questions by displaying the predetermined questions on the field agent computer, the predetermined questions selected so as to minimize financial risk to the insurance carrier of being contractually bound to policy terms unfavorable to the insurance carrier…answering the predetermined questions by inputting answers corresponding to attributes of the subscriber to the identified insurance policy into the field agent computer…updating using the local computer the policy data for the identified insurance policy based on the inputted answers and determining whether the identified policy is eligible for renewal without requiring external underwriting and risk assessment processes…receiving at the field agent computer a proposed renewal policy based on the updated policy data including a premium amount for the subscriber if determined that the identified policy is eligible for renewal…and binding the insurance carrier to the terms and conditions of the proposed renewal policy reflecting the

answers by entering a bind indication into the field agent computer, wherein the binding is accomplished by a decision process undertaken by the field agent without including external underwriting and rating processes."

None of Chapman, National Underwriter, Business Wire or Kern, considered alone or in combination, describe or suggest the method of Claim 3. Specifically, none of Chapman, National Underwriter, Business Wire or Kern, considered alone or in combination, describe or suggest a method for renewing an insurance policy under the authority of a field agent for binding an insurance carrier, the method including providing pre-determined criteria for determining each insurance policy eligible for a renewal evaluation without requiring external underwriting and risk assessment processes, wherein *the no-underwriting eligibility criteria includes whether a change has occurred in an insurance work classification assigned to a subscriber of the corresponding insurance policy being evaluated for renewal without external underwriting and risk assessment processes, and whether a change has occurred in a number of employees of the subscriber.* (Emphasis added.)

More specifically, none of Chapman, National Underwriter, Business Wire or Kern, considered alone or in combination, describe or suggest a *no-underwriting eligibility criteria that includes whether a change has occurred in an insurance work classification assigned to a subscriber of the corresponding insurance policy being evaluated for renewal without external underwriting and risk assessment processes, and whether a change has occurred in a number of employees of the subscriber.* (Emphasis added.)

The Office Action acknowledges that Chapman, National Underwriter and Business Wire fail to teach "the claimed eligibility criteria include an insurance work classification assigned to a subscriber and a number of employees of the subscriber." However, the Office Action asserts that Kern teaches "an automated system and method of compiling rates to be charged for standard worker's compensation policy including the Glen Retirement Center using the classification worksheet enters classification code, number of employees and the payroll (see column 29, lines 38-43)."

The system described in Kern does not describe or teach a pre-determined criteria for determining each insurance policy eligible for a renewal evaluation without requiring external underwriting and risk assessment processes wherein the no-underwriting eligibility criteria includes an insurance work classification or a number of employees. Rather, Kern describes a system that uses information relating to an employer (e.g., Glen Retirement Center) such as job classification, number of full-time employees, number of part-time employees, payroll, and insurance rate for the job classification in order to calculate a premium for providing worker's compensation insurance to the employer. Kern describes that the information used relating to the employer is gathered on a Worksheet as part of the underwriting process of the employer. In other words, Kern describes a system that merely uses information relating to a company for calculating an insurance premium after the company has undergone an underwriting process. Accordingly, Kern does not describe, suggest or even mention *using a pre-determined criteria for determining whether an insurance policy is eligible for a renewal evaluation <u>without requiring external underwriting and risk assessment processes</u> wherein the no-underwriting eligibility criteria includes whether a change has occurred in an insurance work classification assigned to a subscriber of the corresponding insurance policy being evaluated for renewal without external underwriting and risk assessment processes, and whether a change has occurred in a number of employees of the subscriber.* (Emphasis added.)

Applicants respectfully submit that merely describing a system, as shown in Kern, that uses information relating to a company such as a job classification and number of employees to calculate an insurance premium does not describe or teach a pre-determined criteria for determining whether an insurance policy is eligible for a renewal evaluation *<u>without requiring external underwriting and risk assessment processes</u>* as recited in the present claims. In fact, Applicants submit that Kern teaches away from the present invention because Kern teaches calculating a premium *after conducting an underwriting process on a company* that includes gathering information relating to the company to respond to a plurality of questions on a worksheet. Accordingly, Applicants submit that Kern does not describe or suggest the present invention.

For at least the reasons set forth above, Claim 3 is submitted to be patentable over Chapman, National Underwriter and Business Wire and further in view of Kern.

Claims 19-20 depend from independent Claim 3. When the recitations of Claims 19-20 are considered in combination with the recitations of Claim 3, Applicants submit that dependent Claims 19-20 likewise are patentable over Chapman, National Underwriter and Business Wire and further in view of Kern.

Claims 17-18 depend from independent Claim 1. Claim 1 is recited hereinabove.

None of Chapman, National Underwriter, Business Wire or Kern, considered alone or in combination, describe or suggest a method as recited in Claim 1. Accordingly, for at least the reasons set forth above, Claim 1 is submitted to be patentable over Chapman, National Underwriter and Business Wire and further in view of Kern.

When the recitations of Claims 17-18 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 17-18 likewise are patentable over Chapman, National Underwriter and Business Wire and further in view of Kern.

Claims 21-22 depend from independent Claim 15. Claim 15 is recited hereinabove.

None of Chapman, National Underwriter, Business Wire or Kern, considered alone or in combination, describe or suggest a policy renewal system as recited in Claim 15. Accordingly, for at least the reasons set forth above, Claim 15 is submitted to be patentable over Chapman, National Underwriter and Business Wire and further in view of Kern.

When the recitations of Claims 21-22 are considered in combination with the recitations of Claim 15, Applicants submit that dependent Claims 21-22 likewise are patentable over Chapman, National Underwriter and Business Wire and further in view of Kern.

Claims 24-32 depend from independent Claim 23. Claim 23 is recited hereinabove.

None of Chapman, National Underwriter, Business Wire or Kern, considered alone or in combination, describe or suggest a system for renewing an insurance policy as recited in Claim

23. Accordingly, for at least the reasons set forth above, Claim 23 is submitted to be patentable over Chapman, National Underwriter and Business Wire and further in view of Kern.

When the recitations of Claims 24-32 are considered in combination with the recitations of Claim 23, Applicants submit that dependent Claims 24-32 likewise are patentable over Chapman, National Underwriter and Business Wire and further in view of Kern.

For at least the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 17-22 and 24-32 be withdrawn.

In addition to the arguments set forth above, Applicants further submit that the rejection of Claims 1-11, 13-16 and 23 under 35 U.S.C. § 103(a) as being unpatentable over Chapman and National Underwriter in view of Business Wire; the rejection of Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Chapman and National Underwriter in view of Business Wire and further in view of the Official Notice; and the rejection of Claims 17-22 and 24-32 under 35 U.S.C. § 103(a) as being unpatentable over Chapman, National Underwriter and Business Wire and further in view of Kern are further traversed on the grounds that the Section 103 rejection of the presently pending claims is not a proper rejection.

Obviousness cannot be established by merely suggesting that it would have been obvious to one of ordinary skill in the art to modify Chapman using the teachings of National Underwriter, Business Wire, the Official Notice, or Kern. More specifically, as is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

None of Chapman, National Underwriter, Business Wire, the Official Notice, or Kern, considered alone or in combination, describe or suggest the claimed combination. Rather, the present Section 103 rejection is based on a combination of teachings selected from multiple references in an attempt to arrive at the claimed invention. Since there is no teaching, suggestion or motivation for the combination of Chapman, National Underwriter, Business Wire, the Official Notice, or Kern, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejections of Claims 1-32 be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the rejections of Claims 1-32 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in the application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

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